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PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 99-499)

In the Application of:)
Chou et al.)
Serial No.: 08/903,944)
Filing Date: July 31, 1997)
For: Production of Transgenic Poinsettia)

Examiner: D. Fox
Group Art Unit: 1638
Confirmation No.: 3007

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450


TRANSMITTAL LETTER

Dear Sir:

- In regard to the above identified application,
1. We are transmitting herewith the attached:
 - a) Request for Reconsideration of Patent Term Adjustment Determination; and
 - b) Return Receipt Postcard.
 2. With respect to fees:
 - a) Please charge our Deposit Account No. 13-2490 in the amount of \$200 for the Request for Reconsideration of Patent Term Adjustment Determination Fee.
 - b) Please charge any underpayment or credit any overpayment to our Deposit Account No. 13-2490.
 3. CERTIFICATE OF MAILING UNDER 37 CFR § 1.8: The undersigned hereby certifies that this Transmittal Letter and the papers, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on November 3, 2006.

Respectfully submitted,

Date: November 3, 2006

By: 
Michael S. Greenfield
Registration Number 37,142



PATENT

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PO Box 1450
Alexandria, Virginia 22313-1450

Request for Reconsideration of Patent Term Adjustment Determination

Dear Sir:

The Applicants respectfully request reconsideration of the Patent Term Adjustment Determination. The Issue Notification for the above-referenced application stated that there was a Patent Term Adjustment of 0 days, while the published patent indicates a PTA of 519 days. Applicants further note that PAIR currently indicates that 1047 days of delay are charged against the PTO, while 528 days of delay are charged against Applicants, resulting in a PTA calculation of 519 days in the Applicant's favor.

Applicants were charged with a delay of 35 days upon the verification of payment of the issue fee on September 6, 2006. In response to the Final Rejection of February 1, 2006, Applicants filed an Amendment on April 3, 2006, within the three month period set for reply. Additionally, Applicants paid the issue fee on September 6, 2006, within the three month period from the date of the Notice of Allowance set for payment of the issue fee. Applicants can find no basis for the 35 day delay charged to the Applicant and submit that it is unwarranted. Therefore, Applicants respectfully request reconsideration of the delay of 35 days charged against the Applicants.

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Applicants were also charged with a delay of 114 days upon the filing of a Terminal Disclaimer on January 6, 2006. As a preliminary matter, the Applicants note a clerical error in the date listed in PAIR for the filing of this terminal disclaimer; the terminal disclaimer was filed on January 6, 2006, not January 6, **2005**. Applicants filed a response on December 23, 2005, to the Non-final Rejection of September 19, 2005, and therefore submit that a delay of only 4 days is chargeable against Applicants. The filing of a Terminal Disclaimer was not required to fully address the Non-final Rejection of September 19, 2005, nor did it require the mailing of a supplemental Office Action, and therefore Applicants did not engage in delay by filing this Terminal Disclaimer on January 6, 2006. Applicants submit that 110 days of the 114 days charged against the Applicants are unwarranted, and therefore Applicants respectfully request reconsideration of the delay of 110 days charged against Applicants.

Furthermore, Applicants respectfully submit that the Patent Term Adjustment should reflect an additional 259 days of delay charged against the PTO for delay in prosecuting the application. 37 CFR 1.703(a)(5) states that the PTA may be increased by

the number of days, if any, in the period beginning after the date that is four months after the final decision by the Board of Patent Appeals and Interferences... where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. § 132 or a Notice of Allowance under 35 U.S.C. § 151, whichever occurs first.

Applicants respectfully contend that the Examiner's Non-Final Rejection of September 19, 2005, which followed a reversal of all rejections by the Board of Appeals, was improper, and, therefore, Applicants should be granted an additional 259 days due to the Examiner's delay of prosecution.

Applicants submit that the Examiner's Non-Final Rejection of September 19, 2005, was improper under MPEP § 1204.04, which states:

a complete reversal of the examiner's rejection brings the case up for immediate action by the examiner. If the reversal does not place an application in condition for allowance (e.g., the Board has entered a new ground of rejection under 37 CFR § 41.05(b), the examiner should refer to the situations outlined in MPEP § 1214.06 for appropriate guidance.

Applicants contend that nothing in the Appeal, the Board's decision, or any action by the Applicants prompted or justified further examination of the claims. The Board did not suggest

amendments to the claims or issue new rejections, but, in fact, completely reversed the Examiner's rejections. The claims that ultimately issued are the very same claims pending at the time of the Board's decision reversing all rejections.

MPEP § 1204.04 goes on to state:

the examiner should never regard such a reversal as a challenge to make a new search to uncover other or better references... If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center Director for authorization to reopen prosecution under 37 CFR § 1.198 for the purpose of entering the new rejection... The TC Director's approval is placed on the action reopening prosecution.

There is no evidence of record that the Examiner of this application submitted the matter to the Director, nor that the Director's authorization was obtained to reopen prosecution; there is no approval by the TC Director on the action following the Board's reversal of all rejections.

Furthermore, Applications respectfully note that 37 CFR § 1.104(a)(1) requires that the Examiner make "a thorough study [of the application] and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application... and to the patentability of the invention as claimed..." 37 CFR § 1.104(b) states that "The Examiner's action will be complete as to all matters..." Applicants contend that the Examiner's Non-Final Action of September 19, 2005, and the subsequent Final Action of February 2, 2006, were untimely new rejections made without the authorization of the Director, nor necessitated by any action of the Board or the Applicants. Applicants submit that a Notice of Allowance should have been issued no later than September 20, 2005, four months after the Board's decision. Applicants respectfully submit that the delay during the period between September 20, 2005 and the date of the Notice of Allowance, June 6, 2006, a total of 259 days, should be added to the Patent Term Adjustment Determination.

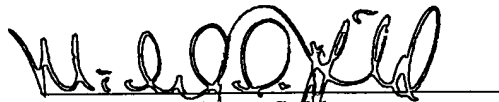
In summary, the Applicants request that the 145 days of delay charged against them be withdrawn and an additional 259 days of delay chargeable to the PTO should be added to the

term of the present patent for a total of an additional 404 days. Therefore, the Applicants request that the Patent Term Adjustment Determination be corrected to reflect 923 days of patent term.

As the patent term adjustment indicated in the Notice of Allowance was adjusted in the Issue Notification, the Applicants could not have applied for a patent term adjustment under 37 C.F.R. 1.705(b), and therefore this request should not be dismissed as untimely.

Respectfully submitted,

Date: November 3, 2006

A handwritten signature in black ink, appearing to read "Michael S. Greenfield", written over a horizontal line.

Michael S. Greenfield
Registration No. 37,142

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